

REMARKS

Claims 1-3 are pending in the Application, and claims 11-14 are newly presented. Applicants respectfully request reconsideration and allowance of this Application in view of the following remarks.

Rejection Under 35 U.S.C. § 112

The Examiner has withdrawn the previous rejection under 35 U.S.C. § 103 based on Lindstrom et al. and Kuhnhold et al. However, claim 1 is now rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Doderer-Winkler, U.S. Patent No. 5,429,576. Applicants respectfully traverse the rejection on the basis that Doderer-Winkler does not disclose (at least) the claim-specified attaching roller as having a set adhesive strength.

Doderer-Winkler discloses a placing roller 78 that includes vacuum holes or “other means” to maintain in place tape strips having adhesive on only one side, with the non-adhesive side of each tape strip facing the placing roller 78 (column 7, lines 58-63). Doderer-Winkler does not specify or suggest at all any sort of “other means” that could be used in place of the vacuum holes to retain the non-adhesive side of the tape strips against the roller. Furthermore, Doderer-Winkler discloses that a suction barrier may be used to block suction in the placing roller 78 to transfer the tape strips to an envelope, or that it may be necessary to use positive pressure to transfer the tape strips (column 8, lines 23-26). Thus, Doderer-Winkler does not disclose that the placing roller 78 has a set adhesive strength because the placing roller 78 relies upon vacuum holes to secure the tape strips - not adhesive strength. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Rejections Under 35 U.S.C. § 103

Claim 1 is also rejected under 35 U.S.C. § 103(a) over Doderer-Winkler in view of Rodriguez, U.S. Patent No. 5,178,717. According to the Office Action, in rejecting claim 1 under 35 U.S.C. § 102, the Examiner interpreted the vacuum generated by the placing roller in Doderer-Winkler as constituting an adhesive strength. In rejecting the claims under 35 U.S.C. § 103, the Examiner “hedges” that argument by asserting that even if the vacuum

does not constitute adhesive strength, the claim is invalid because it would have been obvious to use an adhesive roller as shown in Rodriguez in place of the vacuum roller used in Doderer-Winkler. (Applicants respectfully submit that the fact that the Examiner makes such a “fallback” rejection supports the assertion above that Doderer-Winkler does not anticipate claim 1 because it does not disclose adhesive strength.) Applicants respectfully traverse the rejection because Rodriguez does not remedy the deficiencies of Doderer-Winkler. In particular, the combined teaching of Doderer-Winkler and Rodriguez does not disclose or suggest an attaching roller having a set adhesion to a non-adhesive surface of an adhesive tape.

non bk! The Examiner alleges that it would have been obvious to one of ordinary skill in the art to use a silicone rubber roller, as disclosed by Rodriguez, as the placing roller in the Doderer-Winkler device to adhere to a non-adhesive surface of a tape. (Although the present application specifies that the rubber is “silicon,” this is clearly a typographical error and the present application is clearly intended to refer to silicone rubber.) Applicants disagree.

Rodriguez discloses that the roller must be slightly tacky to the strip of double-sided adhesive, but not so tacky that it will not easily release the strip, and that silicone rubber is preferred (column 3, lines 15-19). However, Rodriguez does not teach that the roller must be slightly tacky to a non-adhesive surface of a tape. The Rodriguez roller contacts an adhesive surface of the double-sided adhesive strip; therefore, in Rodriguez, the adhesive strength between the roller and the strip is due at least in part to the strip's adhesiveness. Rodriguez is completely silent as to any adhesive affinity of the roller for a tape absent any strip adhesive.

Furthermore, Rodriguez discloses additional “rubbery” materials as being suitable for use as the roller, e.g., neoprene, nylon, butadiene rubber, polyolefin elastomers, etc. (see column 3, lines 19-22). Such materials would not have an adhesive strength relative to a non-adhesive surface of a tape and, depending on the particular composition of the material, could even inhibit adhesion (e.g., in order to easily release the adhesive strip). Therefore, operation of the Rodriguez device clearly does not require a roller that adheres to a non-adhesive surface of a tape. Accordingly, one of ordinary skill in the art would not have construed Rodriguez as disclosing that a tacky roller is required.

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The Examiner alleges that “silicone rubber [inherently] exhibits adhesive strength” in view of the present application, which discloses that the attaching roller uses silicone rubber to provide adherence in its surface. However, although the silicone rubber is disclosed in the present application as having an adhesive strength, it is not true that all silicone rubber compounds necessarily exhibit adhesive strength to a non-adhesive surface. That attribute is a result of the specific composition of the silicone rubber, which would be well appreciated by one having skill in the art. Accordingly, the Examiner cannot properly rely upon an inherency argument that a silicone rubber roller, as shown in Rodriguez, would necessarily provide an adhesive strength if combined with the Doderer-Winkler device because Rodriguez only discloses that silicone rubber as used therein is slightly tacky to an adhesive strip; Rodriguez does not disclose that the silicone rubber used therein would adhere to a non-adhesive surface. Accordingly, Applicants respectfully request that the rejection be withdrawn.

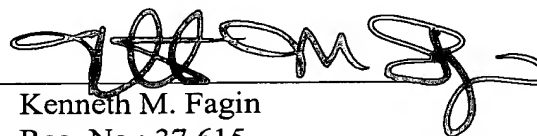
Claims 1-3 are also rejected under 35 U.S.C. § 103(a) over Kluger, U.S. Patent No. 3,713,948, Lindstrom et al., Adachi, and Rodriguez. With respect to the rejection of claim 1, the Examiner again relies upon the Rodriguez silicone rubber roller and the inherency argument that silicone rubber exhibits adhesive strength (based on the present disclosure) in order to remedy the deficiencies of the primary reference. Accordingly, Applicants traverse the rejection for at least the same reasons set forth above and respectfully request that the rejection be withdrawn.

In view of the foregoing, Applicants respectfully submit that all claims are in condition for allowance, and timely Notice to that effect is respectfully requested.

Respectfully submitted,

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